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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,501	05/10/2001	Michael Bleser	29488/36831A	6411

4743 7590 03/10/2005

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EXAMINER

POINVIL, FRANTZY

ART UNIT PAPER NUMBER

3628

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/852,501

Applicant(s)

BLESER ET AL.

Examiner

Frantzy Poinvil

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi et al (US Patent No. 6,473,500) in view of Walker et al (US Patent No. 6,193,155).

As per claims 1, 7, 12, 14 and 17, Risafi et al disclose a system and method for selling a giftcard at a store location of a first retailer for use at a second retailer (see column 5, lines 17), the method comprising:

Displaying a plurality of non-activated giftcards in the store location of the first retailer (column 10, lines 32-51; column 16, lines 11-33 and column 18, lines 43-59);

Activating a selected one of the displayed giftcards upon receipt of a purchase amount from a customer (column 10, lines 32-51; column 16, lines 11-33 and column 18, lines 43-59);

Forwarding information pertaining to the selected giftcard to a processor or server computer associated with the second retailer (column 16, lines 11-33) (the TELCO is a second retailer);

Transferring proceeds from the first retailer to the second retailer, the proceeds including at least a portion of the purchase amount (column 16, lines 11-30; column 11, line 58 to column 12, lines 19).

An activation record is maintained by the PDC. Note column 13, lines 54-63; column 8, lines 15-21 and column 7, lines 30-43.

Applicant argues that Risafi et al do not explicitly teach a giftcard.

These are cards that are useable by a user to use in performing a financial transaction. Whether or not a giftcard is stated in Risafi et al., the Examiner notes that the giftcard as claimed or the card described in Risafi et al are used in the same manner for performing a financial transaction.

Risafi et al do not explicitly teach or suggest designating a second retailer with whom the giftcard may be exclusively used. Walker et al disclose a method and apparatus for issuing and managing gift certificates. See the abstract. In so doing, Walker et al teach that a user purchasing the giftcertificate may select merchants or retailers in which the gift recipient may use the gift certificate. Applicant is directed to column 5, lines 25-38 of Walker et al.

It would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the teachings of Walker et al into Risafi et al in order to allow a plurality of merchants to participate in the overall system which would benefit both purchasers and retailers, thereby making the system attractive to all users.

As per features that the giftcards are disposable cards, Risafi et al do not explicitly teach their cards or giftcards are disposable giftcards. Walker et al disclose that the gift certificate may be a single use financial instrument, thus meeting features of a disposable financial instrument. See column 8, lines 6-64 of Walker et al.

Incorporating a disposable giftcard as taught by Walker et al in the system of Risafi et al would have been obvious to one of ordinary skill in the art in order to allow better accounting control of the giftcards or gift certificates.

As per claims 2 and 8, Risafi et al disclose calculating a revenue share of the purchase amount for the first retailer. See column 11, lines 58-64 and column 9, lines 44-50.

As per claims 3 and 9, the giftcard has a preset credit value. Note column 9, lines 42-46 and column 10, lines 33-38.

As per claim 4, the giftcards are displayed at the first retailer, each set of giftcards being redeemable at a different second retailer. See column 16, lines 11-15; column 17, line 65 to column 18, line 3 of Risafi et al.

As per claim 5, the processor is provided by the second retailer (which is the TELCO processor), see column 16, lines 11-33 of Risafi et al.

As per claim 6, the processor is provided by a third party associated with the second retailer which is the PDC (see column 16, lines 11-33 and column 10, lines 44-49).

As per claim 10, the claimed “plurality of second retailers comprises an outside retailer consortium” is read as a plurality of merchants where goods and services are sold/provided. See column 17, line 65 to column 18, line 3 of Risafi et al. The claimed “and in which the processor is provided by the outside retailers consortium” is read as the processors of the second retailers or the TELCO. Note also column 16, lines 11-33 of Risafi et al.

As per claim 11, the claimed “plurality of second retailers comprises an outside retailer consortium” is read as a plurality of merchants where goods and services are sold/provided. See

column 17, line 65 to column 18, line 3 of Risafi et al. The claimed “and in which the processor is provided by a third party associated with the outside retailers retailer” is read as the PDC.

Note also column 16, lines 11-33 and column 10, lines 44-49 of Risafi et al.

As per claim 13, the first retailer comprises a first retail chain, and wherein the second and different retailer comprises a second retail chain. Note column 17, line 65 to column 17, line 3 and column 10, lines 51-54 of Risafi et al.

As per claim 15, the activation record is accessible by the third party. See column 13, lines 54-63; column 8, lines 15-21 and column 7, lines 30-43.

As per claim 16, the giftcard is provided by the first retailer, see column 18, lines 44-60 and column 16, lines 11-33 of Risafi et al.

As per claim 18, the giftcard is associated with at least one store location of a plurality of additional and different retailers, the processor accessible by the plurality of additional and different retailers, and wherein the portion of the purchase amount is available for transfer from the first retailer to a selected one of the plurality of additional and different retailers. (column 16, lines 11-30; column 11, line 58 to column 12, lines 19).

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-18 do not recite any structure or functionality to suggest that a computer performs the recited claims. The claimed features of transferring information to a server are merely nominal uses of a computer. Thus, claims 1-18 are rejected as being directed to non-statutory subject matter.

## RESPONSE:

In regard to applicant's arguments that the claimed invention is directed to statutory subject matter, the Examiner respectfully disagrees with applicant's assertion. Applicant's assertion is in contradiction with current mandate and reliance on recent court decisions. The instant claims 1-18 lack a practical application in the technological arts. The claims as recited fail to include the guidelines established by the Federal Circuit in the *State Street Bank* decision in which it was established that a statutory claim must recite a practical application in the technological arts. Further support by the Examiner is found in *In re Toma* where it is sated " 'technological arts' or 'useful' arts inquiry must focus on whether claimed subject matter, for example, method operating machine to translate, is statutory, not on whether product of claimed subject matter, for example, translated text, is statutory, not on whether prior art that claimed subject matter purports to replace, for example, translation by human mind, is statutory, and not on whether claimed subject matter is presently perceived to be improvement over prior art, for example whether it 'enhances' operation of machine; this was the law prior to *Gottschalk v. Benson*, 175 USPQ 673, and was not changed by *Benson*." (emphasis added) 197 USPQ 852, 853 (CCPA 1978). In *In re Musgrave*, 167 USPQ 280 (CCPA 1970), it was held that ...all that is necessary to make a sequence of operational steps a statutory 'process' within 35 USC 101 is that it built in the technological arts so as to be in consonance with Constitutional purpose to promote progress of 'useful arts'..." (emphasis added).

In the instant claims the term "server computer" is only a trivial usage. The claims do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompass any product of the class configured in any manner to perform



the underlying process. The claimed invention further does not include any transformation and thus no practical application in the technological arts exists.

Consequently, the claims remain to be analyzed based upon the underlying process, and remain to be rejected as being directed to a non-statutory subject matter.

**In regard to the 35 USC 103 rejection:**

Applicant's representative argues that Risafi et al and Walker fail to teach or suggest the claimed invention. The Examiner disagrees and asserts that Risafi et al is clearly directed to a system and method for purchasing a giftcard. In Walker, the user or purchaser selects the merchants or retailers in which the gift recipient may use the gift certificate. The selected merchants or retailers are similar to the claimed plurality of designated second retailers. Applicant's argument that in the Walker reference, the gift recipient is the entity selecting or designating second retailers to use or redeem the gift recipient teaches away from the claimed invention and concludes that such teaches away from the claimed invention is not convincing. The entity designated the selected second retailers is not an inventive concept which should be accorded a patentable difference. Furthermore, in the independent claims, it is not recited which entity (the purchaser or recipient of the giftcard) is designating the second retailers to with whom the giftcard may be exclusively used. The claim merely recites "designating a second retailer with whom the giftcard may be exclusively used". It is not specifically recited which entity is performing the designating step or function.

Applicant has cited numerous court decisions in support of the above noted assertion and further states that Risafi and Walker are improper combination.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Risafi et al disclose a system and method for selling a giftcard at a store location of a first retailer for use at a second retailer (see column 5). Walker et al teach that a user purchasing the giftcertificate may select merchants or retailers in which the gift recipient may use the gift certificate. Applicant is directed to column lines 25-58 of Walker et al. Combining Risafi et al with Walker et al would have resulted the claimed invention as noted above.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant then argues that neither Risafi nor Walker are concerned with designating a second retailer at which the gif card user may redeem the giftcard nor an entity activating a selected one of the displayed giftcards for exclusively use with the designated second retailer upon receipt of a purchase amount from a customer. Applicant further states that in their system, redemption is not contingent on the existence of a valid credit account as recited in Walker.

In response, the entity performing a specific function is not recited in the claims. See the above noted arguments. Also, the process of redeeming the amount on the giftcard or the giftcard is not recited in the claims. Claims 6, 10 and 15 recite the server computer is associated with the second retailers. However, the claims do not detail how the server computer is "being associated" with the second retailers. Thus, many possible scenarios exist. Thus, the combination of Risafi and Walker meet this limitation.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


**Conclusion**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FP  
February 16, 2005

  
FRANTZY POINVIL  
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